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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,086	09/09/2003	Shiro Majima	09868/000M893-USO	1394
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EXAMINER				
WILLIAMS, ROSS A				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/658,086

Applicant(s)

MAJIMA ET AL.

Examiner

ROSS A. WILLIAMS

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/6/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-23, 31-39 and 41-56 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-23, 31-39 and 41-56 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

Claims 8, 24 – 30 and 40 have been cancelled.

Claims 1, 6, 9, 11-13, 17, 22, 33, 38, 41, 44, 45, 51

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 – 7, 9 – 14, 17 – 23, 33 – 39, 41 – 47, 49 – 51 and 54 - 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bussick et al (US 7,070,502) in view of Walker (US 6,203,430).

Claims 1 – 4, 17 – 20, 33, 34, 35, 36, 38, 49, 54, and 56: Bussick discloses a game machine wherein the display consists of a static display and a changing display. Bussick discloses a game machine that provides a player with increased chances to win

awards and money based upon what type of symbols are displayed on the static display and what type of symbols are displayed on the changing display. Bussick discloses a reel game wherein the player is awarded based upon the winning combinations that are found on specified regions of the reels such as paylines. Bussick discloses awarding payouts to a player based upon winning combinations found upon a "static display", wherein the Examiner is interpreting "static display" to mean the display immediately after the reels stop spinning, and a "changing display", wherein the Examiner is interpreting "changing display" to mean the display after the reels change to display new winning combinations due to special symbols such as wild symbols (2:35 – 56, 2:57 – 3:12). Bussick discloses the operation of the game machine as can be demonstrated by FIGS 5A – 15B and the accompanying explanation. To illustrate, the Examiner draws attention to FIGS 5A and 5B. After a player actuates the game machine and causes the game machine to spin the reels, the reels will display randomly generated symbols. Some of the randomly generated symbols will be wild symbols. In the first step of awarding players the game will award the players with payouts based upon the amount and different types of winning combinations that are found on the paylines. This takes into account winning paylines based upon wild symbols that substitute for other symbols in a winning combination. This takes place during the static display. In the second step of awarding players with payouts the display "changes" by substituting regular symbols with the wild symbols and the player is awarded payouts for the new combinations made by the newly change symbols. The payouts determined in the second step are added to the payouts determined in the step (7:47 – 8:16). Thus as can be seen the

game machine has to find or determine the symbols to be changed to wild symbols. Thus, the symbols to be changed are accounted for in some way such as by counting or measuring how many there are in any given display. The player is awarded points or payouts based upon the number of them and how many winning combinations are made before and after the change. Bussick discloses a game machine that counts the number of times a designated symbol is displayed on the reels and awards payouts based upon that particular symbol and the combinations that it makes. Bussick does not disclose displaying a count wherein the count is how many times that the symbol was displayed on the reels. Walker discloses a game machine wherein designated symbols are tracked and counted. The total number of times that the symbol is counted is displayed upon the game machine display. The player is awarded payouts based upon the count reaching specific thresholds (Walker 3:42 – 51, FIG 3B).

It would be obvious to one of ordinary skill in the art to provide a symbol tracking and display feature to Bussick as it would increase it increases the excitement, anticipation and enjoyment of playing a slot machine. The user would be able to see how immediately how many particular symbols have been displayed on the reels over a period of time and how close they are to attaining potential award thresholds.

Claims 5, 21, 37 and 50: Bussick discloses a payable that determines how much the player is awarded based upon the number of winning symbols in the display (7:3 – 17).

Claims 6, 7, 22, 23 and 39: Bussick discloses a reel display region that is used to display the static and changing display. When symbols are displayed upon appropriate paylines or special regions, the player is awarded payouts (FIGS 5A – 15B).

Claims 9, 10, 41, 43, 44, 45 and 47: Bussick discloses a game machine wherein the machine operates in such a way to change designated symbols on a static and changing reel display into wild symbols as discussed in reference to claim 1. However Bussick also discloses an alternate method wherein instead of replacing the symbols on the static display and changing display with wild symbols, the game machine will replace one or more symbols with one or more different symbols. The replacement is not a wild symbol (Bussick 11:45 – 54). The game then proceeds in a similar two step evaluation of the achieved winning combinations on the static display and the changing display, before and after the replacement (11:45 – 54). This replacement of symbols with subsymbols is done randomly in that the initial selection of symbols is a random selection of symbols to be displayed on the reels. Thus, any subsequent selection of subsymbols based upon the already randomly selected symbols would also be random.

Claims 11, 42 and 51: Bussick discloses a game machine that selects symbols to be changed into other symbols. After the symbols are changed into subsequent symbols the newly changed symbols can be thought of as “special” symbols.

Claims 12 – 14 and 46: Bussick discloses a plurality of special region displays that are known commonly referred to as paylines (Bussick FIG 6A, 6B, reference #56a,b,c). Bussick further discloses that when designated symbols are displayed on

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the display one or more of them can be changed into a plurality of other different symbols (i.e. sub-symbols), as discussed above.

Claim 55: Walker discloses the multiplying of the count by the amount bet (Walker 9:26 – 31).

Claims 15, 16, 31, 32, 48, 52 and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bussick et al (US 7,070,502) in view of Walker (US 6,203,430) in view of Berman (US 2003/0045345).

Claims 15, 16, 31, 32, 48, 52 and 53: Bussick discloses the use of special regions such as paylines to determine when winning combinations are present on the display screen. However Bussick does not disclose the use of randomly generated special regions or randomly generated paylines. Berman discloses the use of dynamic paylines that are generated base upon certain symbols being displayed on the symbol display screen (Berman par 0035 – 0040). Due to the fact that the symbols are randomly determined, the dynamic paylines are also randomly determined. It would be obvious to one of ordinary skill in the art to modify Bussick in view of Berman to provide randomly generated paylines. This would create a more exciting game for the player, as they would not be able to anticipate what paylines are available.

Response to Arguments

Applicant's arguments filed 9/6/2007 have been fully considered but they are not persuasive.

The Applicant states " Thus, and in sharp contrast to Applicants' amended independent claim 1, Walker fails to disclose or otherwise describe a slot machine in which a measuring module measures the number of times that a special symbol is displayed for a reel in a changing display state. The Examiner respectfully disagrees and points to the above rejection of the claims to explain as to how the Examiner is interpreting the Applicant's claims of a "changing display state" and a "static display state" in regards to Bussick. The Applicant states that the combination of Bussick and Walker would not be obvious because the "count" of Walker represents the number of times the tracked symbol occurs in a generated outcome. The Applicant further states that this outcome is therefore equivalent to the Applicant's "static display state", since an outcome represents the result of a game and leads to an associated payout for a player. The Examiner agrees that this is a reasonable comparison of the Applicant's claimed invention to the disclosure of Walker, however the static and changing display states of Bussick are set forth as above. Walker is relied upon for showing that in an outcome that is displayed to the user certain symbols may be tracked and accounted for and the tracked symbols counts may be displayed to the user. Since Bussick discloses the two displays states as explained in the above rejection, it would be obvious to use Walker to display a count of symbols in the changing display state as discussed above.

The Applicant further asserts " Applicants claimed measuring module operates to count the display of special symbols during the changing display state by counting "the number of times the kicker symbol (special symbol) passes the payline starting with when the reels start spinning and ending when they stop (step 5)" (emphasis added).

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Applicants submit that this feature of Applicants' claimed invention is not taught or suggested by Walker, or either of the other cited references (Bussick and Berman)."

The Examiner respectfully points out that the features in the example that the Applicant has used to illustrate the claimed invention contains limiting language that is not found in the claims. For example "the number of times the kicker symbol (special symbol) passes the payline starting with when the reels start spinning and ending when they stop." Although the claims are interpreted in light of the specification, limitations in the specification are not read into the claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROSS A. WILLIAMS whose telephone number is (571)272-5911. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. A. W./
Examiner, Art Unit 3714

/Ronald Laneau/
Supervisory Patent Examiner, Art Unit 3714
04/12/08